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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,962	11/10/2000	Lars Severinsson	3323-P0001C	6142

24126 7590 01/27/2003

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[REDACTED] EXAMINER

SCHWARTZ, CHRISTOPHER P

ART UNIT	PAPER NUMBER
3683	

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/710,962</b>	Applicant(s) <b>Severinsson</b>
Examiner <b>Schwartz</b>	Art Unit <b>3683</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Jun 18, 2002

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 19-22 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 19-22 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      6)  Other: \_\_\_\_\_

*Christopher P. Schwartz*  
CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER

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### **DETAILED ACTION**

1. Applicant's response has been received.
2. Applicant's remarks have been considered but the examiner maintains substantially the same position outlined in the previous office action.

#### ***Claim Rejections - 35 U.S.C. 251***

3. Claim 25 remains rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Regarding claim 25 note applicants omit claiming the cover as a part of a self sustained unit in a brake mechanism.

In the parent case 08/817769 the limitation of the cover was claimed in combination with the housing, see patent claim 1 line 3 (note the examiner made an amendment to this claim to

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overcome 112 second paragraph combination-subcombination problems at that time). Note also in the patent claim beginning with line 5 applicant claims structure, namely “two thrust sleeves (8)... *arranged on the cover* for disposal in the housing...”

In the specification of the patent 5,833,035 column 2 note line 29 “....but the cover and the rest of the mechanism are also *held together as a unit...*”.

At page 6 over to page 7 of applicants remarks in the original application 08/817769 applicants stated “Parent claim 1 is amended to better structurally define applicants novel feature wherein the housing and cover members are structured with the *entire braking unit carried by the cover* independently from the housing to be inserted as a unit”.

Note also applicants remarks in paper no. 5 filed in the first reissue application 09/324506. At page 4 line 13 applicants state “the “mechanism as a unit” is clearly disclosed, wherein the cover and the rest of the mechanism is held together in the absence of the housing 1”. At page 5 line 10 in the same amendment applicants state “However, applicant provides a unitary assembly that is assembled outside the housing and thus is inserted as a unit into the housing”. Presumably this “unit” must include the cover. These latter remarks were directed at distinguishing applicants invention from the Antony et al. reference.

From these arguments it is remains unclear then how the cover can be left out of the picture if the inner workings of the brake mechanism are attached to it for insertion into the housing “as a unit”. It therefore remains the examiner’s position that the invention, as originally

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claimed, is the combination of the housing and the cover and the inner workings of the brake mechanism.

One of the errors in the declaration submitted in the parent reissue states “.. that no independent claim is broadly directed to the concept that the two thrust sleeves, cross bar and lever are preassembled as a unit prior to installation in the caliper”... Upon further consideration this supposed error is somewhat confusing because the first set of independent claims (13 and 21) filed with the parent reissue case both had the cover limitation in them. The “error” in the declaration hinted nothing about the omission of the cover as the basis for the reissue. Note also that nowhere in the specification does it state these specific elements (bearing tappets and thrust sleeves) are preassembled without the cover.

#### *Response to Arguments*

4. Applicant's arguments filed 6/18/02 have been fully considered but they are not persuasive.

As discussed on page 5 in the response filed 6/18/02 applicant's argue “the cover does not relate to surrendered subject matter, as the cover itself was not added and no arguments about the presence of the cover itself were made in an effort to overcome a prior art rejection.” Further it is argued that there was no argument made that the cover itself was required for novelty and that the examiner has already indicated that the cover is not required for novelty by specifically indicating the claims are patentable over the prior art of record.

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The examiner maintains that applicants presented **arguments** in the original ('769) application the cover was a necessary limitation for novelty. At page 6 over to page 7 of applicants remarks in the original application 08/817769 applicants stated "Parent claim 1 is amended to better structurally define applicants novel feature wherein the housing and cover members are structured with the *entire braking unit carried by the cover* independently from the housing to be inserted as a unit".

Note also applicants remarks in paper no. 5 filed in the first reissue application 09/324506. At page 4 line 13 applicants state "the "mechanism as a unit" is clearly disclosed, wherein the cover and the rest of the mechanism is held together in the absence of the housing 1".

The surrender of claimed subject matter can occur by argument alone. *See Hester Industries, Inc. V. Stein, Inc.* 142 F.3d 1472 (Fed. Cir. 1998). Further, the issue of patentability (novelty) and the issue of recapture are independent. Just because the claims have been indicated to be patentable over the prior art of record does not mean the recapture rule no longer applies.

### ***Conclusion***

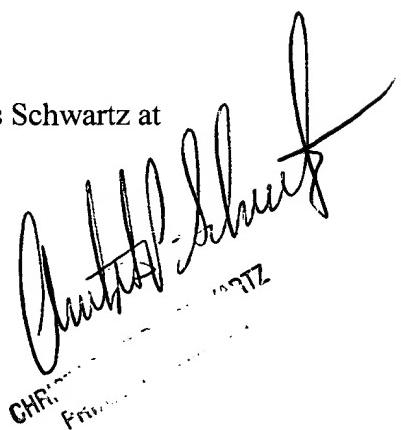
**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication should be directed to Chris Schwartz at telephone number (703) 308-0576..



A handwritten signature of "Chris Schwartz" is written in black ink. Below the signature, the name "CHRIS SCHWARTZ" is printed in a stylized, all-caps font, with "CHRIS" on the first line and "SCHWARTZ" on the second line, separated by a diagonal line.